

references in the proposed manner. More particularly, Applicants argued that simply because the top surface of the outer cover 108 of the House reference has anti-static properties, this would not necessarily teach one of ordinary skill in the art to make each sheet in a mouse pad (i.e. of the Great Britain reference) have anti-static properties.

In the "Response to Arguments" section, the final Office action takes the position that the disclosure of the House reference teaches one of ordinary skill in the art to make each sheet in the mouse pad of the Great Britain reference have anti-static properties. The Office action submits this is so that, because at one time or another, each sheet of the mouse pad will be the top sheet.

However, it is respectfully submitted that this line of reasoning entirely ignores the physical differences and the differing principles of operations between the cited references. More particularly, the House reference is directed to a work-surface covering pad with a *hard outer cover* 108. The outer cover 108 is disclosed to made of, for example, polyvinylchloride, polycarbonate, polystyrene, polyester, acetate films or scratch resistant vinyl (column 4, line 51-55). This hard outer cover is a different structure, and serves an entirely different purpose from, the sheets of a mouse pad.

The Office action does not make clear whether it proposes that one of ordinary skill in the art would: 1) apply the top outer cover 108 of the House reference onto each sheet of a mouse pad to thereby provide the anti-static property to the sheets; or 2) somehow simply "lift" the antistatic properties of the top outer cover 108 of House and apply such anti-static properties to each sheet of a mouse pad. However, it is submitted that one of ordinary skill in the art would not carry out either modification.

If the Office action proposes, under option 1), that it would have been "obvious" to place a hard outer cover 108 on *each and every page* of the mouse pad of the Great Britain reference, then it can be seen that the resultant structure would be unworkable. A mouse pad with a plurality of thick polycarbonate (for example) "covers" interleaved therein would result in an unduly thick, stiff, and unwieldy mouse pad. The bulk and weight of the "covers" would appear to significantly outweigh that of the pages. The "covers" would provide the dominant structure to the mouse pad and convert it to an essentially unrecognizable, and unworkable, structure.

Thus it is submitted that one of ordinary skill in the art would not be motivated to modify the reference in this manner.

On the other hand, if the Office action proposes, under option 2), that it would be obvious to utilize the anti-static properties of the cover 108 of House on the individual sheets of a mouse pad, then such a proposal is also rebutted for other reasons. For example, as previously noted, this proposed modification ignores the physical differences between the rigid, plastic cover 108 of the House reference and the paper sheets of the mouse pad of the Great Britain reference. For example, in the embodiments of Figs. 5, 7 and 9 of the House reference, the hard outer cover 108 receives a plurality of sheet materials 140 thereunder (see column 6, lines 1-43; and column 7, line 54). The House reference does not disclose that those sheets 140 have any anti-static property. Instead, it is only the hard, protective outer cover 108 that is disclosed to have any anti-static properties. Thus, if the House reference were to somehow be combined with the Great Britain reference, the result would be that the mouse pad of the Great Britain reference would have the outer cover 108 of the House reference located on the top thereof; the individual sheets would not have an anti-static property.

By way of analogy, consider a prior art reference directed to a convertible automobile that discloses a protective water-proof coating on the roof of the automobile. Using the line of reasoning applied in the Office action, it would be obvious to one of ordinary skill in the art to apply that protective water-proof coating to the *seats* of automobile since the seats will, at some time, be exposed to the elements. However, the coating of the "roof" (i.e. the polymer protective cover 108 of House) is simply not anywhere disclosed to be used on the "seats" (i.e. underlying paper sheets of either the House or the Great Britain reference). In addition, just as one would suspect that a water-proof coating of an automobile roof would not necessarily be compatible with the leather or fabric of an automobile seat, there is no evidence that the anti-static coating, treatment or properties utilized on the transparent, hard, textured outer cover 108 would be usable on or compatible with the paper sheets of the Great Britain reference.

Finally, it should be noted that the House reference inherently teaches against the modification proposed in the Office action. The House reference has paper sheets 140; just as the Great Britain reference has paper sheets (of a mouse pad). The House reference does not anywhere disclose that its paper sheets are treated with an anti-static coating. Thus the Office

action proposes a "modification" that is inherently contradicted (in that it could be utilized; but is not) by the House reference itself.

Moreover, it remains Applicants' position that the Office action does not provide a proper motivation for the proposed modification. More particularly, at page 3, the final Office action argues that it would have been obvious to make each sheet of the GB mouse pad have anti-static properties "in order to avoid collecting dirt on the mouse pad." However, this motivation is identical to that recited in the application at page 3, lines 16-21 wherein it is noted that the anti-static nature of the sheets "reduces dust accumulation and reduces interference with the electrical components of the mouse to help ensure proper functioning of the mouse. The reduced dust accumulation on the sheets 12 also reduces dust accumulation in the mouse."

MPEP §2145 notes that "any judgment on obviousness is in a sense a reconstruction based on hindsight reasoning, but so long as it...*does not include knowledge claimed only from applicants' disclosure*, such a reconstruction is proper." In this case, the Office action uses an identical benefit cited in the application to reconstruct Applicants' invention.

In the "Response to Arguments" section, the final Office action appears to attempt to address this issue by referring to U.S. Pat. No. 6,240,879 to Denesuk et al. and 5,953,052 to McNelley, and takes the position that these references supply a motivation for the proposed modification. However, the Denesuk and McNelley references do not appear to have been cited by the Office in a form PTO-892 "Notice of Reference Cited," and these references also do not appear to have been cited by the Applicants in an Information Disclosure Statement.

In addition the Denesuk and McNelley references are not formally applied in any rejection. Instead, the final Office action makes only a passing mention of these references in the "Response to Arguments" section. Accordingly, Applicants need not respond to this casual mention to the Denesuk and McNelley patents since they are not part of any rejection of the claims.

Further evidence that the Denesuk and McNelley references are not properly applied in a formal rejection can be found on the basis that the Office action mailed on December 13, 2006 is indicated to be a "final" Office action. However, Applicants' Response mailed on September 25, 2006 did not amend the claims in any manner. Accordingly, if the Denesuk and McNelley references are, in fact, to be applied in a formal rejection, the Office action mailed on December

13, 2006 could not be a final rejection (MPEP §706.07(a)). On the other hand, if it is the Office's position that the Denesuk and McNelley references are in fact applied in a formal rejection, then the finality of the Office action should be withdrawn under MPEP §706.07(d) so that Applicants can more fully respond.

Finally, the "Response to Arguments" section in the Office action also argues that having anti-static properties on an object is "well-known" and would have been readily apparent to a person having ordinary skill in the art reading the House reference. However, it is submitted that there are various reasons to having anti-static properties on an object, and the House reference only generically indicates that it "may be beneficial" to have anti-static properties on the cover 108.

Accordingly, on at least the bases that: 1) one of ordinary skill in the art would not carry out the proposed modification; and 2) the Office action does not provide a sufficient motivation for the proposed modification, it is submitted that the rejection of claims 1, 2, 4-14, 16, 28, 29, 39, 42 and 43 over the Great Britain reference, in light of the "Mouse Pad Calendar" web page print-out, and in light of the House reference, is improper and should be withdrawn.

Claims 44-46, 48 and 49 are rejected as being unpatentable over the Great Britain reference, in view of the "Mouse Pad Calendar" web page print-out, and in light of U.S. statutory Invention Registration H377 to Greig. However, as previously noted, the cited references simply do not disclose the claimed subject matter. More particularly, claim 44 specifies that each sheet is *not* directly joined to any adjacent sheet and to any intermediate sheet *along each edge* of each sheet. In contrast, in both Fig. 3 and Fig. 4 of the Greig reference, an adhesive strip 20 extends *entirely along* an adjacent edge of the sheet. The claimed "intermediate location" of claims 44 and 48 is simply not shown in the Greig reference.

The final Office action does not offer any rebuttal or response to these arguments. Thus it is submitted that the rejection of claims 44-46, 48 and 49 over the Great Britain reference, in view of the "Mouse Pad Calendar" web page print-out, and in light of U.S. statutory Invention Registration H377 to Greig, is improper and should be withdrawn.

In sum, it is therefore submitted that the application is in a condition for allowance, and a formal notice thereof is respectfully requested.

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Response

The Commissioner is hereby authorized to charge any additional fees required, including the fee for an extension of time, or to credit any overpayment to Deposit Account 20-0809. The applicant(s) hereby authorizes the Commissioner under 37 C.F.R. §1.136(a)(3) to treat any paper that is filed in this application which requires an extension of time as incorporating a request for such an extension.

Respectfully submitted,



Steven J. Elleman
Reg. No. 41,733

THOMPSON HINE LLP
2000 Courthouse Plaza NE
10 West Second Street
Dayton, Ohio 45402
(937) 443-6838